

REMARKS

I. Summary of the Office Action

Claims 1-36 are pending in the application.

The Examiner objected to the declaration because "it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. 1.56." (Office Action, page 2.)

The Examiner objected to the specification because the claims do not commence on a separate sheet. The Examiner also requested that applicants update the patent application information and any other referenced application numbers in the specification.

Claims 1 and 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nordenstrom et al. U.S. Patent No. 4,289,135 (hereinafter "Nordenstrom").

Claims 10-16, 18, 29, 30, and 36 are rejected under 35 U.S.C. § 102(e) as being anticipated by Berg et al. U.S. Patent Publication No. 2005/0177207 (hereinafter "Berg").

Claim 15, 16, 18, 29, and 36 are rejected under 35 U.S.C. § 102(b) as being anticipated by McCaughan, Jr. U.S. Patent No. 4,660,925 (hereinafter "McCaughan").

Claim 30 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over McCaughan.

Claims 1-6, 8, 10-19, and 21-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8, 10-19, and 21-36 of U.S. Patent No. 6,708,066.

Claims 2-6, 17, 19-28, and 31-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the double patenting rejection and to include

all of the limitations of the base claim and any intervening claims or upon the filing of a Terminal Disclaimer.

Claims 7, 9, and 20 are objected to as being dependent upon a rejected based claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

II. Summary of Applicants' Reply

Applicants wish to thank the Examiner for indicating that claims 2-7, 9, 17, 19-28, and 31-34 contain allowable subject matter and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants have amended independent claim 1 to incorporate dependent claim 2, amended independent claim 10, and have amended independent claim 15 to incorporate dependent claim 17. Applicants have also amended claims 3, 5-9, and 23 to update claim dependencies. Support for the amendments to the claims can be found throughout the application. Amendments to the claims are being made solely to expedite prosecution and do not constitute acquiescence to any of the Examiner's objections or rejections. Applicants' silence with regard to the Examiner's rejection of the dependent claims constitutes a recognition by the applicants that the rejections are moot based on applicants' amendment and/or remarks relative to the independent claim from which the dependent claims depend. Applicants reserve the option to further prosecute the same or similar claims in the present or a subsequent application.

Reconsideration and prompt allowance are respectfully requested.

III. The Defective Declaration

The Examiner states that the “oath or declaration is defective because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. 1.56.” Applicants respectfully submit that the declaration states the inventors “acknowledge the duty to disclose information which is material to the patentability of the claims of this application in accordance with Title 37, C.F.R. § 1.56(a) and § 1.56(b).” Accordingly, applicants request that the objection to the declaration be withdrawn.

IV. The Objections to the Specification

The specification has been objected to for the following informality: “The Claims do not commence on a separate sheet.” The Notice to File Missing Parts of Nonprovisional Application mailed on September 17, 2003 also required that applicants submit “Replacement claim(s) commencing on a separate sheet in compliance with 37 CFR 1.75(h) and 1.121.” In response to the September 17, 2003 Notice to File Missing Parts of Nonprovisional Application, applicants submitted replacement claims in compliance with 37 C.F.R. §§ 1.75(h) and 1.121.

The specification has also been objected to for the following informality: “The examiner requests that the parent application information be updated in the specification along with any other referenced application numbers in the specification that have matured into patents.” (Office Action, pages 2-3). In response, the specification has been amended to recite that the parent application, U.S. Patent Application No. 09/733,023, is now U.S. Patent No. 6,708,066.

Accordingly, applicants request that the objections to the specification be withdrawn.

V. The Prior Art Rejections of Claims 1 and 3-9

The Examiner has rejected independent claim 1 under 35 U.S.C. § 102(b) as being anticipated by Nordenstrom.

Applicants respectfully disagree with the contentions made by the Examiner in the Office Action in connection with these rejections. However, to facilitate allowance, applicants have amended claim 1 to incorporate dependent claim 2, which the Examiner indicated to be allowable. Nothing in this response should be interpreted as applicants' acquiescence to, or agreement with, the Examiner's rejections under § 102(b).

As suggested by the Examiner, independent claim 1 has been amended to recite the limitation of claim 2 and claim 2, which depends from claim 1, has been cancelled.

Accordingly, applicants respectfully submit that independent claim 1 and claims 3-9 and 35, which depend from independent claim 1, are allowable.

VI. The Prior Art Rejections of Claims 10-14

Applicants' independent claim 10 is directed to a kit for treating specified tissue in a patient. Among other things, the apparatus includes a working electrode and a counterelectrode, where each electrode is adapted to be positioned in the patient within or near the tissue, means for applying a voltage effective to induce a current between the electrodes, means for regulating the voltage across the electrodes, a precursor of a compound having cytotoxic activity against the tissue, and means for introducing the precursor into the patient into or near said tissue. The precursor is activated by reaction with at least one of the electrodes to create an electrochemical reaction that yields the cytotoxic activity.

Applicants note that independent claim 10 recites, for example, “a working electrode and a counterelectrode, each electrode adapted to be position in said patient within or near said tissue,” “means for applying a voltage effective to induce a current between the electrodes,” and “means for introducing said precursor into said patient into or near said tissue, said precursor being activated by reaction with at least one of said electrodes.” Accordingly, applicants’ independent claim 10 are therefore allowable for at least the same reasons provided with respect to independent claim 1.

In addition, applicants submit that nothing in the cited sections of Berg, nor in any other section of Berg, disclose or suggests having “means for introducing said precursor into said patient into or near said tissue, said precursor being activated by reaction with at least one of said electrodes, wherein an electrochemical reaction yields the cytotoxic activity.”

Accordingly, applicants respectfully submit that independent claim 10 and claims 11-14, which depend from independent claim 10, are allowable.

VII. The Prior Art Rejections of Claims 15-34 and 36

The Examiner has rejected independent claim 15 under 35 U.S.C. § 102(e) as being anticipated by Berg. The Examiner has also rejected independent claim 15 under 35 U.S.C. § 102(b) as being anticipated by McCaughan.

Applicants respectfully disagree with the contentions made by the Examiner in the Office Action in connection with these rejections. However, to facilitate allowance, applicants have amended claim 15 to incorporate dependent claim 17, which the Examiner indicated to be allowable. Nothing in this response should be interpreted as applicants’ acquiescence to, or agreement with, the Examiner’s rejections under §§ 102(b) and 102(e).

As suggested by the Examiner, independent claim 15 has been amended to recite the limitation of claim 17 and claim 17, which depends from claim 15, has been cancelled.

Accordingly, applicants respectfully submit that independent claim 15 and claims 16-34 and 36, which depend from independent claim 15, are allowable.

VIII. Terminal Disclaimer

The Examiner rejected claims 1-6, 8, 10-19, and 21-36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8, 10-19, and 21-36 of U.S. Patent No. 6,708,066.

Applicants are submitting herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) to obviate the double patenting rejection. The double patenting rejection should therefore be withdrawn.

In accordance with 37 C.F.R. § 1.321(b), applicants authorized the Director to charge the amount of \$130.00 in payment of the fee set forth in 37 C.F.R. § 1.20(d) for the Terminal Disclaimer.

IX. Conclusion

The foregoing demonstrates that claims 1, 3-16, and 18-36 are patentable. This application is therefore in condition for allowance. Reconsideration and prompt allowance are accordingly respectfully requested.

AUTHORIZATION

The Director is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219.

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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